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SHEHATA:M

261

02/16/90

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☐ Claims 1-11 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-11 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☒ not been received
☐ been filed in parent application, serial no. _____; filed on _____.

Art Unit 261

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

2. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one (1) year prior to the date of application for patent in the United States.

3. Claims 1, 5, 7, 9 are rejected under 35 U.S.C. 102b as being anticipated by Siemens Ag.

Considering claim 1, the reading means is considered to be the opto-electric reading eye 2. Since the telephone handset taught by Siemens is capable of reading a telephone number and directly dialing it as described in the abstract, therefore it is inherent that such a device would include recognizing means for recognizing the character data and control means for performing communication processing. The registering means is considered to be the telephones memory bank. Since the telephone taught by Siemens includes a memory bank therefore it is again inherent that such a device would include search means to search through the memory bank.

Considering claim 5, since the telephone taught by Siemens is provided with a memory bank for storing phone numbers and is also provided with dialing means, therefore it is inherent that it includes searching means to search for a phone number in memory bank and includes control means to dial it.

In claim 7, the reading means is considered to

Art Unit 261

be the opto-electric reading eye. The storage means is considered to be the memory bank. It is inherent to have selecting means and control means for reasons discussed above.

In claim 9, the selecting means is considered to be the same as the searching means of claim 5. The applicant is directed to the rejection discussion of claim 5.

4. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 2, 3, 8, 10, 11 are rejected under 35 U.S.C. 103 as being unpatentable over Siemens in view of Kinohara.

Considering claim 8, Kinohara teaches the use of a display to display the phone number to be dialed. It would have been obvious to one of ordinary skill in the art to provide Siemens with a display to display the the read or searched phone number so that user would be

Art Unit 261

assured that he/she would be dialing the correct number. For the same reasons, it also would have been obvious to one of ordinary skill in the art to use the display means to display the read characters and the recognized characters. Therefore claim 2 is rejected.

In claim 3, it would have been obvious to register the characters in the registering means in accordance with the type of the character data, in order to sort the names that are read in association to the phone number that is read.

In claim 10, it would have been obvious to place the opto-electric reading eye on on the upper surface of the hand set to completely guarantee that the hand set cord and the opto-electric reading eye would not foul each other.

In claim 11, it is well known in the art to use liquid crystal display as display devices because they are space and power efficient.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the term "such as" is vague and indefinite. It must not be used.

7. Claims 4, 6 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112 and to include all of the limitations of the base claim and any intervening claims.

8. The prior art made of record and not relied upon

Art Unit 261

is considered pertinent to applicant's disclosure.

Kitagawa and Hughes et al. are cited to further show automatic dialers in use with bar code reader.

Oikawa is cited to also show the use of automatic dialers in association with magnetic card reader.

Kessler is also cited to show the use of bar code readers, magnetic card reader, LCD display and keyboard with an automatic dial system.

Miura is also cited to show the combination of a facsimile, display unit, keyboard and one-touch dialer.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Magdy Shehata whose telephone number is (703) 557-8223.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 557-3321.

M. SHEHATA:sm

703 557-8223

2/8/90


JIN F. NG
SUPERVISORY PRIMARY EXAMINER
ART UNIT 261